

**REMARKS****Summary of the Office Action**

In the Office Action, the Examiner has requested a certified copy of German Priority Application No. 10312848.4.

Claims 4, 5, 7, 8, 10 and 12-15 have been rejected under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph, as being indefinite.

Claims 1-14, 17, 18 and 26 stand rejected under 35 U.S.C. § 102 (b) as being anticipated by U.S. Publication No. 2002/0028418 to *Farag*.

Claims 15 and 16 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Farag* in view of U.S. Publication No. 2001/0037304 to *Paiz*.

**Summary of the Response to the Office Action**

Applicant proposes submitting a certified copy of German Priority Application No. 10312848.4, amending claims 4, 5, 7, 8, 10 and 12-14 to address the 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph rejection, and amending independent claim 1 to address the 35 U.S.C. §§ 102 (b) and 103 (a) rejections.

Based on the arguments presented below, claims 1-18 and 26 are pending for further consideration.

**35 U.S.C. 112, 2<sup>nd</sup> Paragraph Rejections**

In the Office Action, claims 4, 5, 7, 8, 10 and 12-15 stand rejected under 35 U.S.C. 112, 2<sup>nd</sup> Paragraph as being indefinite.

With regard to claims 4, 5, 7 and 8, Applicant respectfully notes that the term “materialized” refers to a “particular” structure that has been chosen out of an infinite number of possibilities (see page 8, line 29 page 9, line 6 of specification). In the interest of expediting prosecution of this application, claims 4, 5, 7 and 8 have been amended to change the term “materialized” to “particular”.

With regard to claim 12, Applicant respectfully notes that the display means and monitor are input equipment as they can take an appropriate input from a keyboard, or if they are of the touch-screen type.

With regard to claim 15, Applicant respectfully notes that the exchange is between the database on the one hand and the operating or display terminal on the other hand.

Applicant therefore respectfully requests withdrawal of the 35 U.S.C. 112, 2<sup>nd</sup> Paragraph rejection of claims 4, 5, 7, 8, 10 and 12-15.

### **All Claims are Allowable**

In the Office Action, claims 1-14, 17, 18 and 26 stand rejected under 35 U.S.C. § 102 (b) as being anticipated by U.S. Publication No. 2002/0028418 to *Farag*. Claims 15 and 16 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Farag* in view of U.S. Publication No. 2001/0037304 to *Paiz*. Applicant respectfully traverses these rejections for the following reasons.

With regard to independent claim 1, Applicant respectfully asserts that *Farag* and *Paiz*, viewed either singly or in combination, fail to teach or fairly suggest a data base for the storage of data, the data base including, “dental data concerning universally applicable dentition-specific features and universally applicable tooth-specific features, wherein the dental data illustrate real teeth as images in digitized form and said digitized form also involves one of universally applicable dentition-specific features, tooth-specific features and structural properties, including at least one of sex-specific, tooth family-specific, biography-specific, and person-specific characteristics, with or without anomalous characteristics,” as recited in independent claim 1, as amended.

Support for these features recited in claim 1 can be found at least on page 3, line 28 to page 9, line 28, and further on page 16, line 7 to page 20, line 28 of the originally filed specification, and in Figs. 1-7 of the originally filed drawings. Specifically, as shown in Figs. 1-7, the present invention provides a data base for the storage of data. The data base includes dental data concerning universally applicable dentition-specific features and universally applicable tooth-specific features. The dental data illustrate real teeth as images in digitized form. The digitized form also involves universally applicable dentition-specific features, tooth-specific features or structural properties. The digitized form also includes sex-specific, tooth family-specific, biography-specific, and/or person-specific characteristics, with or without anomalous characteristics.

With regard to claims 1-18 and 26, the Office Action cites *Farag* and *Paiz* as teaching or suggesting the data base recited in the claims.

*Farag*, as illustrated in Fig. 3 and discussed in Paragraphs 34 and 38 thereof, discloses a method 300 for dental imaging. In a particular embodiment, as noted in the Official Action and discussed in Paragraph 38 of *Farag*, method 300 includes storing 340 the 3-D image in association with patient information.

Contrary to the express recitation in independent claim 1 of the present invention, *Farag* however does not disclose a database with identified tooth-specific structures, but only discloses storage of 3-D images (see Paragraph 38 of *Farag*). While these 3-D images are associated with a patient, these images however are not the same as or equivalent to a database including identified tooth-specific structures which would include information as to a specific region of a tooth from several different teeth of the same type.

For example, as discussed in the original specification on page 16, lines 7-16, "FIG. 1 shows a possible overall access sequence when accessing a tooth data bank. The data base itself contains, in particular, digitized images, such as binary coded images, of real teeth together with tooth-specific and/or dentition-specific data of the kind inevitably and inseparably associated, as structural features, with each individual tooth and/or dentition. These include, in particular, sex-specific and/or tooth family-specific and/or biography-specific and/or person-specific characteristics with or without anomalies." As further discussed in the specification on page 10, lines 5-9, "it is particularly advantageous when the user of the data base (tooth-specific and/or design-specific) has the data available on his own data processing facilities so as to minimize reaction times and, consequently, the processing time."

Thus whereas *Farag* discloses a general database with the data of a person's tooth, *Farag* however does not teach or suggest the aforementioned advantages of using a data base with tooth-specific dental data, and clearly does not disclose a data base including, "dental data concerning universally applicable dentition-specific features and universally applicable tooth-specific features," as recited in claim 1, as amended.

With regard to the teachings of *Paiz*, which has been cited for teaching the providing of data to a user through a computer network system in exchange for payment as recited in

dependent claims 15 and 16, Applicant respectfully asserts that *Paiz* fails to overcome the aforementioned deficiencies in the teachings of *Farag*.

As pointed out in MPEP § 2131, “[t]o anticipate a claim, the reference must teach every element of the claim.” “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”

*Verdegaal Bros. v. Union Oil Co. Of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

Moreover, as pointed out in M.P.E.P. § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). Since these criteria have not been met, Applicant respectfully asserts that the rejections under 35 U.S.C. § 102 (b) and § 103 (a) should be withdrawn because *Farag* and *Paiz* do not teach or suggest each feature of independent claim 1, as amended.

In view of the above arguments, Applicant respectfully requests the rejection of independent claim 1 under 35 U.S.C. § 102 be withdrawn. Additionally, claims 2-18 and 26, which depend from independent claim 1, are allowable at least because their base claim is allowable, as well as for the additional features recited therein.

### **CONCLUSION**

In view of the foregoing, Applicant respectfully requests reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the response, the Examiner is invited to contact the Applicant’s undersigned representative to expedite prosecution.

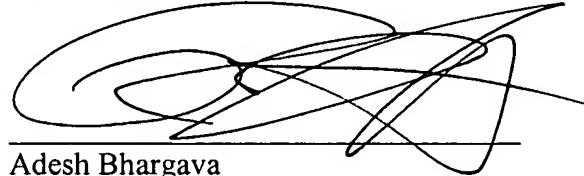
If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 04-2223. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

**DYKEMA GOSSETT PLLC**

Dated: October 23, 2006

By:

A handwritten signature in black ink, appearing to read 'Adesh Bhargava', is written over a horizontal line.

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